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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/710,143
Filing Date: November 10, 2000
Appellant(s): BOURKE-DUNPHY ET AL.

Himanshu S. Amin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/10/2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed on 12/23/2003 has not been entered.

The amendment after final rejection filed on 3/17/2004 has not been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-21 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,963,743	Amberg et al.	10-1999
5,666,501	Jones et al.	9-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 5-9, 13-16, 19-211 are rejected under 35 U.S.C. 102(b).

Claims 3-4, 10-12, 17-20 are rejected under 35 U.S.C. 103(a).

This rejection is set forth in a prior Office Action, mailed on 9/24/2003 (Paper No. 6), and reproduced below with argumentation added to further clarify and/or in response to issues have been raised by the Brief.

(11) Response to Argument

A. Amberg et al. does not teach "configuration characteristics for the software system being determined based on the location scenario"(Re Brief, Page 4).

Answer:

Examiner respectfully disagree with Appellant's assertion that Amberg et al. does not teach "configuration characteristics for the software system being determined based on the location scenario"(Re Brief, page 4, lines 11-14) by characterizing that Amberg et al. simply discloses configuring a target system solely according to an order and the network is merely utilized for communication (Re Brief, page 4, last 2 lines). However, it should be noted that each "order" is equivalent to each "location scenario" (E.g. see FIG. 3A, item 300 and associated text). In particularly, Amberg et al. disclose as follow:

Col. 5:32-33, which states "...an order is received for a target computer system (location specific scenario) ..." (emphasis added);

Col. 5:38-43, which states "... Regardless of the means of taking or the form of the order, the order includes the type of target computer system which a customer desires to purchase and, possibly, an explicit listing of the particular components (order/customer/location specific scenario) the customer wishes that target computer system to include ..." (emphasis added);

Col. 5:47-50, which states "...The target computer system order is also provided to the software installation and testing system (location specific scenario) where it is piped into a conversion program in module 320 ..." (emphasis added); and

Col. 5:54-65, which states "...the BAR file (location specific scenario) contains a unique identifier which identifies the specific target computer system being manufactured... Finally, the BAR file may contain customer-specific information such as name ..." (emphasis added).

Furthermore, Amberg et al. provides a means for facilitating software installation, which is more than just "merely utilized for communication" because, it has to return a build-to-order back to a unique identifier according to a customer-specific information (E.g. see col. 5:54-65,

with emphasis added); the build-to-order is also provided to the software installation and testing system (E.g. see col. 5:47-50).

Accordingly, examniner believes that with all of the notes and as emphasis added above, Amberg et al. does teach each of his "order" is, at least, equivalent to each "location scenario" as recited in the plain language of the claim. Accordingly Amberg et al. indeed teach "configuration characteristics for the software system being determined based on the location scenario".

B. In conclusion of the group B argument, Appellant merely argues that Amberg et al. does not teach "configuration characteristics for the software system being determined based on the location scenario"(Re Brief, Page 5, lines 17-19).

Answer:

Again as noted above, examiner respectfully disagree with Appellant's assertion that Amberg et al. does not teach "configuration characteristics for the software system being determined based on the location scenario"(Re Brief, Page 5, lines 17-19).

Again, it should be noted that each Amberg et al "order" is, at least, equivalent to each "location scenario" as recited in the plain language of the claim. Accordingly Amberg et al. indeed teach "configuration characteristics for the software system being determined based on the location scenario". Because in Amberg et al., as noted above, at least each order, build-to-order, must return back to a unique identifier (specific location scenario) according to a customer-specific information (E.g. see col. 5:54-65, with emphasis added); the build-to-order is also provided to the software installation and testing system (E.g. see col. 5:47-50).

For the above reasons, it is believed that the rejections should be sustained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-9, 13-16, 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Amberg et al. (US Patent No. 5,963,743).

In regarding to claims 1,7-8, Amberg et al. teaches ***a setup component that receives information indicative of a location scenario related to where the software system is being installed***,(See Fig. 1, item 140, Column 4, line 1-3; "computer system...target system 160") ***configuration characteristics for the software system being determined based on the location scenario***(See Fig. 1, item 140, Column 4, line 5-10; "sequencing program ... conversion module 94" and See Fig. 2, item 192, Column 4, line 48-58; "Fig.2 is ... by the customer").

It should be noted that each "order" is equivalent to each "location scenario" (E.g. see FIG. 3A, item 300 and associated text). In particularly, Amberg et al. disclose as follow:

Col. 5:32-33, which states "...an order is received for a target computer system (location specific scenario) ..." (emphasis added);

Col. 5:38-43, which states "... Regardless of the means of taking or the form of the order, the order includes the type of target computer system which a customer desires to purchase and, possibly, an explicit listing of the particular components (order/customer/location specific scenario) the customer wishes that target computer system to include ..." (emphasis added);

Col. 5:47-50, which states "...The target computer system order is also provided to the software installation and testing system (location specific scenario) where it is piped into a conversion program in module 320 ..." (emphasis added); and

Col. 5:54-65, which states "...the BAR file (location specific scenario) contains a unique identifier which identifies the specific target computer system being manufactured... Finally, the BAR file may contain customer-specific information such as name ..." (emphasis added).

Furthermore, Amberg et al. provides a means for facilitating software installation, which is more than just "merely utilized for communication" because, it has to return a build-to-order back to a unique identifier according to a customer-specific information (E.g. see col. 5:54-65); the build-to-order is also provided to the software installation and testing system (E.g. see col. 5:47-50).

In regard to claims 2, 9 and 16, the rejection of claims 1, 8, 15 are incorporated respectively and further Amberg et al. teaches ***a plurality of available components, the configuration characteristics further include default components selected for installation from the plurality of available components based on the location scenario.*** (See Fig. 1, Column 4, line 14-18; "the component descriptors ... target system 160") and (E.g. see Col. 5:38-43, which states "... Regardless of the means of taking or the form of the order, the order includes the type of target computer system which a customer desires to purchase and, possibly, an explicit listing of the particular components (order/customer/location specific scenario) the customer wishes that target computer system to include ..." (emphasis added).

In regard to claims 5, 13 and 21, the rejection of claims 1, 8, 15 are incorporated respectively and further Amberg et al. teaches ***including computer-executable instructions associated with the setup component for accessing stored system information and determining configuration characteristics associated with a location onto where the software system is being installed, the location scenario being determined based on the configuration characteristics.*** (See Column 1, line 61-65; "The diskette ... being purchased"), and (E.g. see Col. 5:32-33, which states "...an order is received for a target computer system (location specific scenario) ..." (emphasis added), and (E.g. see Col. 5:47-50, which states "...The target computer system order is also provided to the software installation and testing system (location specific scenario) where it is piped into a conversion program in module 320 ..." (emphasis added) and (E.g. see Col. 5:54-65, which states "...the BAR file (location specific scenario) contains a unique identifier which

identifies the specific target computer system being manufactured... Finally, the BAR file may contain customer-specific information such as name ..." (emphasis added).

In regard to claims 6 and 14, the rejection of claims 1, 8 are incorporated respectively and further Amberg et al. teaches ***a server system having a plurality of server components and the location scenario is selected from at least two scenarios including a central server scenario and a branch office server scenario.*** (See Fig. 2, item 100, Column 4, line 59-67, Column 5, line 1-5; "To sequence ... from database 100") and (E.g. see Col. 5:38-43, which states "... Regardless of the means of taking or the form of the order, the order includes the type of target computer system which a customer desires to purchase and, possibly, an explicit listing of the particular components (order/customer/location specific scenario) the customer wishes that target computer system to include ..." (emphasis added).

In regard to claim 15, Amberg et al. teaches a ***computer-readable medium having computer-executable instructions for receiving data indicative of a location scenario where a software system is to be installed; and configuring the software system based on the location scenario.*** (See Fig. 2, Column 4, line 30-36; "Having sequenced ... target system 160").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-4, 10-12, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amberg et al. (US Patent No. 5,963,743) in view of Jones et al. (US Patent No. 5,666,501).

In regard to claims 3, 4 and12, the rejection of claims 1, 8 are incorporated respectively and further Amberg et al. teaches a setup component for receiving information indicative of a location scenario relating to where the software system is being installed. (See Fig. 1, item 140,

Column 4, line 1-3; "computer system...target system 160") configuration characteristics for the software system being determined based on the location scenario, (See Fig. 1, item 140, Column 4, line 5-10; "sequencing program ... conversion module 94" and See Fig. 2, item 192, Column 4, line 48-58; "Fig.2 is ... by the customer") but Amberg et al. doesn't fairly suggest a location user interface component. However, Jones et al. teaches ***at least two location scenarios associated with installation of the software system, the location user interface component sets the location scenario in response to receipt of an associated user input.*** (See Fig. 2, Column 3, line 16-21; "Fig. 2 illustrates ... local machine", and See Fig. 2, Column 3, line 29-37; "each bundle contains ... particular source object"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a user interface, as suggested by Jones et al., to help in installing the software component in location-based scenarios system configuration. The modification would have been obvious because one of ordinary skill in the art would have been motivated to combine user interface in software installation and provide flexibility in software installation to the user.

In regard to claims10 and 17, the rejection of claims 9, 16 are incorporated respectively and further Amberg et al. teaches a plurality of available components, the configuration characteristics further including default components selected for installation from the plurality of available components based on the location scenario, (See Fig. 1, Column 4, line 14-18; "the component descriptors ... target system 160") but Amberg et al. doesn't fairly suggest a user interface which identifies the at least one default component. However, Jones et al. teaches a user interface (See Fig. 2, Column 4, line 25-28; "GUI could have a default selection ... he/she can access"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a user interface, as disclosed by Jones et al., for the purpose to form a user interface which identifies the at least one default component. The modification would have been obvious because one of ordinary skill in the art would have been motivated to combine user interface to identify at least one default component in software installation.

In regard to claim 11, the rejection of claim 10 is incorporated respectively and further Amberg et al. teaches a plurality of available components, the configuration characteristics further including default components selected for installation from the plurality of available components based on the location scenario (See Fig. 1, Column 4, line 14-18; "the component descriptors ... target system 160"), but Amberg et al. doesn't fairly suggest a user interface component for selecting installation of the software. However, Jones et al. teaches a user interface component for selecting installation of the software. (See Fig. 2, Column 3, line 29-37; "each bundle contains ... particular source object"). Therefore, it would have been obvious to one of ordinary skill in the art

at the time the invention was made to use a user interface, as suggested by Jones et al., to install and control software component in selected location-based scenarios. The modification would have been obvious because one of ordinary skill in the art would have been motivated to provide a response to a user in selecting component in software installation.

In regard to claim 18, the rejection of claim 17 is incorporated respectively and further Amberg et al. teaches a computer-readable medium having computer-executable instructions for receiving data indicative of a location scenario where a software system is to be installed; and configuring the software system based on the location scenario, (See Fig. 2, Column 4, line 30-36; "Having sequenced ... target system 160") but Amberg et al. doesn't fairly suggest a user interface. However, Jones et al. teaches a location user interface component for selecting software installed based on user input via the user interface and controlling operating characteristics of at least some of the selected components as a function of the location scenario. (See Fig. 2, Column 3, line 59-64; "Display controls 245 allow ... all prerequisites are satisfied"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a user interface, as suggested by Jones et al., to install and control software component in selected location-based scenarios. The modification would have been obvious because one of ordinary skill in the art would have been motivated to provide a response to a user in selecting component in software installation.

In regard to claim 19, the rejection of claim 15 is incorporated respectively and further Amberg et al. teaches a computer-readable medium having computer-executable instructions, (See Fig. 2, Column 4, line 30-36; "Having sequenced ... target system 160") but Amberg et al. doesn't fairly suggest user interface component for presenting at least two location scenarios associated with installation of the software system, the location user interface component being operative to set the location scenario in response to receiving an associated user input. However, Jones et al. teaches a user interface (See Fig. 2, Column 3, line 21-26; "assuming the GUI ... a local directory"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a user interface, as suggested by Jones et al., to install and control software component in selected location-based scenarios. The modification would have been obvious because one of ordinary skill in the art would have been motivated to provide a response to a user in selecting component in software installation.

In regard to claim 20, Amberg et al. teaches a server system having a plurality of server components and the location scenario is selected from at least two scenarios including a central server scenario and a branch office server scenario. (See Fig. 2, item 100, Column 4, line 59-67, Column 5, line 1-5; "To sequence ... from database 100").

Respectfully submitted,

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August 4, 2004

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